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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/616,368	07/09/2003	Thierry Verpoort	069208.0112	1219

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EXAMINER	
MENON, KRISHNAN S	

ART UNIT	PAPER NUMBER
1723	

DATE MAILED: 12/19/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/616,368	VERPOORT ET AL.	
	Examiner	Art Unit	
	Krishnan S. Menon	1723	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *20 October 2005*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *24,25,27,28 and 36-54* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *24,25,27,28 and 36-54* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Claims 24,25,27,28, and 36-54 are pending after the amendment, 10/20/05

Information Disclosure Statement

Applicant's request to reconsider the foreign-language references, submitted in the IDS of 7/9/03 and not considered in the prior office action, will have to be differed until the office obtains a translation of the references.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

1. Claims 24,27,37-41,42,43 and 48-50 are rejected under 35 U.S.C. 102(b) as being anticipated by, or in the alternative, under 35 USC 103(a) as being obvious over, Katsurada et al (US 5,498,336).

Claims 24, 42: Katsurada teaches a gas plasma-treated polyurethane filter material – see abstract and examples 4-7; the material is fibrous or non-woven fabric – see column 3 lines 5-27; plasma-treated polyurethane is more hydrophilic than the untreated polyurethane (Please note that the increased hydrophilicity is also an inherent property of the treated polyurethane). Regarding the newly added limitation of "oxygen plasma" treated, this limitation adds only a broad process step to the claim, which does

not make the claims patentable. "[E]ven though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." In re *Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985).

Claims 37, 46: 'platelets do not substantially adhere to ...' is an inherent property. Where applicant claims a composition in terms of a function, property or characteristic and the composition of the prior art is the same as that of the claim but the function is not explicitly disclosed by the reference, the examiner may make a rejection under both 35 U.S.C. 102 and 103, expressed as a 102/103 rejection. "There is nothing inconsistent in concurrent rejections for obviousness under 35 U.S.C. 103 and for anticipation under 35 U.S.C. 102." In re Best, 562 F.2d 1252, 1255 n.4, 195 USPQ 430, 433 n.4 (CCPA 1977). This same rationale should also apply to product, apparatus, and process claims claimed in terms of function, property or characteristic. Therefore, a 35 U.S.C. 102/103 rejection is appropriate for these types of claims as well as for composition claims.

Claims 38-41, 48-50: fabric comprises pores – this is inherent in non-woven; pore diameter average 10 μm: example 4, which would be within range of the "approximately" 13 or 8 μm.

Claim 27,43: 'operable to selectively leukodeplete a fluid ... ' recites intended use; A claim containing a "recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus" if the prior art apparatus teaches all the structural limitations of the claim. *Ex parte Masham*, 2 USPQ2d 1647 (Bd. Pat. App. & Inter. 1987)

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

2. Claims 24,25,27,28 and 36-54 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kuroki et al (US 5,707,520) in view of Katsurada et al (US 5,498,336).

Kuroki teaches a plasma-treated (column 15 lines 50-65; column 11 lines 34-39) polyurethane material for fluid filter (examples 3, 10-13, etc., table 5), wherein the plasma treated polyurethane is more hydrophilic than untreated (plasma treatment is done for making polyurethane hydrophilic). Kuroki teaches selective leuko-depletion, and better than 2-log reduction of leukocytes with no more than 10% removal of platelets from a platelet solution (see table 5). Instant claims differ from the teaching of Kuroki in the recitation of 'non-woven fabric' for the porous polyurethane in claim 26. Katsurada teaches that the structure of the filter material can be of various forms such

as fibrous, aggregate, non-woven or woven fabric, etc. (see column 3 lines 5-27). Thus Katsurada teaches the various porous structures of the porous body as equivalent. Kuroki teaches the filter structure required as a porous body with certain porosity and pore diameter ranges (see column 5 line 51 – column 6 line 27; column 17 lines 21-35). Kuroki also teaches that non-woven leukocyte removing filters (natural and synthetic) with good efficiency are common in the art in column 1 lines 45-51. Therefore, it would be obvious to one of ordinary skill in the art at the time of invention that the structure of the porous body as taught by Kuroki can be non-woven as taught by Katsurada, as long as it otherwise meets the requirements of the porous body as required by the teaching of Kuroki. They are considered equivalent unless the applicant can show otherwise with evidence.

It may also be noted that the limitation "operable to selectively leukodeplete ..." is functional language, which is not a positive limitation, but only requires the ability to so perform. While features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function. In re Schreiber, 128 F.3d 1473, 1477-78, 44 USPQ2d 1429, 1431-32 (Fed. Cir. 1997) (The absence of a disclosure in a prior art reference relating to function did not defeat the Board's finding of anticipation of claimed apparatus because the limitations at issue were found to be inherent in the prior art reference); see also In re Swinehart, 439 F.2d 210, 212-13, 169 USPQ 226, 228-29 (CCPA 1971); In re Danly, 263 F.2d 844, 847, 120 USPQ 528, 531 (CCPA 1959). "[A]pparatus claims cover what a device is, not what a device does." Hewlett-Packard

Co. v. Bausch & Lomb Inc., 909 F.2d 1464, 1469, 15 USPQ2d 1525, 1528 (Fed. Cir. 1990).

Response to Arguments

Applicant's arguments filed 10/20/05 have been fully considered but they are not persuasive.

In response to the argument between oxygen and argon plasma treatment, the applicant's claims do not recite any structural difference resulting from the oxygen plasma treatment. There is no disclosure in the specification which relates to oxygen plasma treatment, other than making the polyurethane more hydrophilic; and the references teach making the polyurethane more hydrophilic by plasma treatment with various gases/vapors.

In response to the argument that the reference filters are designed to remove platelets: on the contrary, at least the Kuroki reference teaches removal of platelets is less than 10%, which is within the limitation of applicant's claims.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not

mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Krishnan S. Menon whose telephone number is 571-272-1143. The examiner can normally be reached on 8:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wanda L. Walker can be reached on 571-272-1151. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Joseph Drodge

JOSEPH DRODGE
PRIMARY EXAMINER

Krishnan Menon
Patent Examiner
12/5/05